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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,558	03/21/2001	John T. Andrews	18433.00	2627

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EXAMINER

HO, THOMAS Y

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/812,558

**Applicant(s)**

ANDREWS ET AL.

**Examiner**

Thomas Y Ho

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-15 is/are rejected.
- 7) ☒ Claim(s) 6 and 16-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

~~Claims 1-20 are pending. No claim shave been withdrawn or cancelled.~~

### ***Claim Objections***

Claim 10 is objected to because of the following informalities:

As to claim 10, "said clamping device" lacks antecedent basis, and also it appears that "a fixed jaw" and "a stationary jaw" refer to the same element, and references to the same structure should be consistent throughout the claims.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-14 are rejected under 35 U.S.C. 101 because as to claim 13, the claimed invention is directed to non-statutory subject matter. Applicant claims a wearer's pierced body part, and human body parts are non-statutory. Claim 14 depends from claim 13.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Glick**

**US5693073.**

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As to claim 15, Glick discloses, a vibrating body jewelry device for attachment to a body part (mouth) of a user, comprising: a housing 30 having a threaded recess defined therein (col.3, ln.40-45); a vibratory motor unit 74 disposed in the housing, the vibratory motor unit having a contact node depending therefrom (the vibrator unit has switches that are contact nodes; col.5, ln.30-35); a battery 76 disposed in the housing; a flexible cushioned barrier 86 (col.5, ln.45-67; col.6, ln.1-10) disposed between the vibratory motor unit and the battery, the barrier having a recess (space between the conductors) defined therein aligned with the contact node; at least one post 20,40 having a threaded first end (on 20) and having a second end, the first end being threaded into the recess defined in the housing; and attachment means for securing the vibrating body jewelry item to a body part of a user (the large bulbous portion is an equivalent attachment means to the bulbous keeper disclosed by applicant, and serves an equivalent function; the large bulbous portion in Glick retains the pacifier in a hole/mouth on the user in an identical manner as the spherical attachment means disclosed by applicant); wherein, the post is movable between a first position in which the barrier separates the battery from the contact node in order to prevent the device from vibrating, and a second position in which the post forces the battery against the contact node in order to activate the vibratory motor unit (col.5, ln.45-67; col.6, ln.1-10).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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**Claims 1-3, 5, and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolbel US3750655 in view of Moriarty US6193742.**

As to claim 1, Kolbel discloses, a vibrating body jewelry item to be attached to a body part of a user, comprising: a power source 32; a vibrating motor unit 19; a housing 10 having a first (bottom of 10a) and second section 10b dimensioned and configured to contain said power source and said vibrating motor unit, each said first and second sections having mating ends that connect to one another; attachment means 1,2 for securing the vibrating body jewelry item to a body part of a user; and a post (neck portion of 10a), said housing being disposed at one end of said post, and said attachment means being disposed at an opposite end of said post. The difference between the claim and Kolbel is the claim recites, wherein said power source is disposed within said housing. Moriarty discloses a vibratory massage device similar to that of Kolbel. In addition, Moriarty further teaches a power source disposed with a motor in a housing 50 (as see in Figure 2), and furthermore, also teaches the equivalence of having a battery in a housing, and an external power source 61 attached to a housing by a wire (which is identical to the apparatus 32 of Kolbel). It would have been obvious to one of ordinary skill in the art, having the disclosures of Kolbel and Moriarty before him at the time the invention was made, to modify the power source of Kolbel to be a battery in the housing, as in Moriarty, to obtain an untethered power source. One would have been motivated to make such a combination because having an internal battery source and using a cable coupled to an outside source are equivalent, as taught by Moriarty. Inasmuch as the references disclose these elements as art recognized equivalents, it would have been obvious to one of ordinary skill in the exercise art to substitute one for the other. In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982).

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As to claim 2, Moriarty teaches, wherein said power source 48 is a battery.

As to claim 3, Kolbel discloses, wherein said ends of said first and second sections of said housing include thread means 15 for threadably connecting said sections together.

As to claim 5, Kolbel discloses, wherein said second section of said housing includes a recess. Moriarty teaches said housing is a recess, said power source is a battery, and said battery being received in said recess.

As to claim 7, Kolbel discloses, wherein said attachment means for securing the vibrating body jewelry item to a body part of a user is a keeper.

As to claim 8, Kolbel discloses, wherein said keeper is configured to receive an attachment selected from the group consisting of a chain, charm, and other ornamental jewelry piece item. The keeper 1,2 is a clamp that is "configured" to clamp any number of objects. This claim holds little patentable weight because it is purely functional. Furthermore, the cited reference of Kolbel could perform the necessary function.

As to claim 9, Kolbel discloses, wherein said attachment means for securing the vibrating body jewelry item to a body part of a user is a clamp.

As to claim 10, Kolbel discloses, wherein said clamping device includes a movable jaw 2 and a fixed jaw 1, said movable jaw mating with a stationary jaw to form said clamp device.

As to claim 11, Kolbel discloses, a vibrating body jewelry item to be attached to a body part of a user, comprising: a power source; a vibrating motor unit; a housing 10b dimensioned and configured to contain said power source and said vibrating motor unit; attachment means for securing the vibrating body jewelry item to a body part of a user; a post 10a, said housing being disposed at one end of said post, and said attachment means being disposed at an opposite end of

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said post. Moriarty teaches, wherein said power source and said vibrating motor unit are disposed within said housing.

As to claim 12, Kolbel discloses, wherein said post has a threaded end and said housing has a threaded recess 15 formed therethrough, and wherein the threaded end extends through the threaded recess. The difference between the claim and Kolbel is the claim recites, to selectively engage said vibrating motor unit with said power source. Moriarty discloses a vibrating massage device similar to that of Kolbel. In addition, Moriarty further teaches a housing, wherein the cap portion may actuate the switch by turning (col.4, ln.15-21) to selectively engage the motor unit and power source. It would have been obvious to one of ordinary skill in the art, having the disclosures of Kolbel and Moriarty before him at the time the invention was made, to modify the threaded housing/cap of Kolbel to cause engagement of the power source to the motor unit, as in Moriarty, to obtain a cap that opens and closes a switch by rotation. One would have been motivated to make such a combination because the ability to change switch positions (essentially connect and disconnect a battery) would have been achieved, as taught by Moriarty.

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolbel US3750655 in view of Moriarty US6193742, and further in view of Glick US5693073.**

As to claim 4, the difference between the claim and Kolbel is the claim recites mating snap-fit structures in place of the threaded portions. Glick discloses a vibratory massage device similar to that of Kolbel. In addition, Glick further teaches the equivalence of threads and snap-fit configurations to join sections of the housing (col.3, ln.40-55). It would have been obvious to one of ordinary skill in the art, having the disclosures of Kolbel and Glick before him at the time the invention was made, to modify the threaded fastening portions of Kolbel to be replaced with

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snap-fit configurations, as in Glick, to obtain an alternative fastening means. One would have been motivated to make such a combination because Glick teaches that both fastening means are equivalent and interchangeable. Inasmuch as the references disclose these elements as art recognized equivalents, it would have been obvious to one of ordinary skill in the exercise art to substitute one for the other. In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982).

***Allowable Subject Matter***

Claims 6 and 16-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 13 would overcome the rejection under 35 U.S.C. 101 if rewritten to recite "...means includes a post --adapted for inserting-- [inserted] through a wearer's pierced body part...". Upon overcoming the rejection under 35 U.S.C. 101, claims 13-14 would be objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

As to claim 6, applicant recites a post having a threaded end and said housing has a threaded recess defined in the second section, wherein the post extends through the threaded recess. The closest prior art of Kolbel US3750655 shows a housing having the claimed second section, but only with the second section and the post being a unitary assembly, and so the post in Moriarty does not extend through the recess in the second section because they are integral to one another.



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As to claims 16-17, the prior art of record fails to disclose or suggest the device being adapted for attachment to a pierced body part with the post extending through the body part.

As to claim 18, the closest prior art of record, Glick US5693073, fails to disclose or suggest the attachment means comprising a clamp. Kolbel US3750655 teaches a clamp on the end of a vibrating massage device, but Glick is an infant pacifier for a user's mouth, and having a clamp on the end would destroy the intent of Glick's invention.

As to claim 19, the prior art of record fails to disclose or suggest first, second, and third posts.

As to claim 20, the closest prior art of record, Glick US5693073 discloses a housing 30, and a post 20,40 as claimed in claim 15, from which claim 20 depends. However, claim 20 also recites that the housing must have a first and a second section, the first and second sections having mating male and female threaded connectors. The prior art of record fails to disclose or suggest modifying the unitary housing 30 in Glick to be separated into the joined first and second sections.

### ***Response to Arguments***

Applicant's arguments, see pg. 8-19, filed 1/20/04, with respect to the rejection(s) of claim(s) 1-20 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the art cited in the detailed action above.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TYH

A handwritten signature in black ink, appearing to read "Robert J. Swann", is located at the bottom right of the page.